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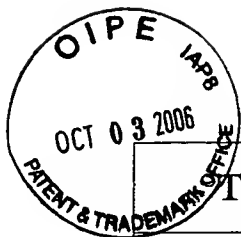
Effective on 12/08/2004. Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818). FEE TRANSMITTAL For FY 2005		Complete if Known	
		Application Number	09/995,287-Conf. #1957
		Filing Date	November 26, 2001
		First Named Inventor	J. A. Bly
		Examiner Name	C. L. Hewitt
		Art Unit	3621
<input type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27		Attorney Docket No.	65678-0043
TOTAL AMOUNT OF PAYMENT	(\$) 500.00		

METHOD OF PAYMENT (check all that apply)	
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1. BASIC FILING, SEARCH, AND EXAMINATION FEES							
	FILING FEES		SEARCH FEES		EXAMINATION FEES		
		Small Entity		Small Entity		Small Entity	
Application Type	Fee (\$)	Fee (\$)	Fee (\$)	Fee (\$)	Fee (\$)	Fee (\$)	Fees Paid (\$)
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	
2. EXCESS CLAIM FEES							
						Small Entity	
						Fee (\$)	Fee (\$)
Fee Description							
Each claim over 20 (including Reissues)						50	25
Each independent claim over 3 (including Reissues)						200	100
Multiple dependent claims						360	180
Total Claims		Extra Claims	Fee (\$)	Fee Paid (\$)	Multiple Dependent Claims		
- =		x	=		Fee (\$)	Fee Paid (\$)	
HP = highest number of total claims paid for, if greater than 20.							
Indep. Claims		Extra Claims	Fee (\$)	Fee Paid (\$)			
- =		x	=				
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3. APPLICATION SIZE FEE							
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SUBMITTED BY			
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Fee Transmittal	
I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the U.S. Postal Service on the date shown below with sufficient postage as First Class Mail, in an envelope addressed to: MS Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.	
Dated: September 28, 2006	Signature: <u>Heather Edwards</u> (Heather Edwards)



IFW/AF

TRANSMITTAL OF APPEAL BRIEF

Docket No.
65678-0043

In re Application of: J. A. Bly et al.

Application No.
09/995,287-Conf. #1957

Filing Date
November 26, 2001

Examiner
C. L. Hewitt

Group Art Unit
3621

Invention: SYSTEM AND METHOD FOR TRACKING USER CERTIFICATION AND TRAINING

TO THE COMMISSIONER OF PATENTS:

Transmitted herewith is the Appeal Brief in this application, with respect to the Notice of Appeal filed: July 28, 2006

The fee for filing this Appeal Brief is \$ 500.00

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Dated: September 28, 2006

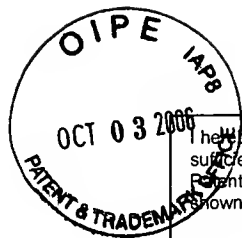
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Appeal Brief Transmittal

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Dated: September 28, 2006

Signature: Heather Edwards (Heather Edwards)



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Dated: September 28, 2006

Signature:

Heather Edwards
(Heather Edwards)

Docket No.: 65678-0043
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
J.A. Bly et al.

Application No.: 09/995,287

Confirmation No.: 1957

Filed: November 26, 2001

Art Unit: 3621

For: SYSTEM AND METHOD FOR TRACKING
USER CERTIFICATION AND TRAINING

Examiner: C.L. Hewitt

APPEAL BRIEF

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This appeal is from the decision of the Primary Examiner dated March 29, 2006 ("Final Office Action"), finally rejecting claims 36 - 62, which are reproduced as an Appendix to this brief. The Notice of Appeal was filed on July 28, 2006. This application was filed on November 26, 2001.

As required under § 41.37(a), this brief is filed within two months of the Notice of Appeal filed in this case on July 28, 2006, and is in furtherance of said Notice of Appeal.

The fees required under § 41.20(b)(2) are dealt with in the accompanying
TRANSMITTAL OF APPEAL BRIEF.

This brief contains the headings as required by 37 C.F.R. § 41.37 and M.P.E.P. § 1206.

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I. REAL PARTY IN INTEREST

The Real Party-In-Interest is Dana Corporation, located at 4500 Dorr Street, P.O. Box 1000, Toledo, Ohio 43697. Dana Corporation was assigned all rights to the U.S. Patent Application identified by Serial No. 09/995,287 on May 15, 2003 by Dana Commercial Credit Corporation of 660 Beaver Creek Circle, Maumee, Ohio 43537.

II. RELATED APPEALS AND INTERFERENCES

On July 9, 2003, Appellant filed a notice of appeal, and on September 9, 2003 Appellant filed an Appeal Brief, appealing the final rejection of U.S. Application Serial No. 09/441,289. On January 7, 2005, this Board issued a decision reversing the Examiner's rejection of all pending claims (claims 16 and 21-48). Pursuant to 37 C.F.R. § 41.37(c)(1)(ii), a copy of the afore-mentioned decision of this Board is attached hereto in Appendix C. Application 09/441,289 has issued as U.S. Patent No 7,062,446. The application at issue in this appeal is a C-I-P application claiming priority from application 09/441,289.

On July 9, 2003, Appellant filed a notice of appeal, and on September 9, 2003 Appellant filed an Appeal Brief, appealing the final rejection of U.S. Application Serial No. 09/504,000, filed February 14, 2000 as a C-I-P application claiming priority from application 09/441,289. Appellant received an Office Action proposing to re-open prosecution on July 22, 2005. However, Appellant elected to continue the Appeal, and filed a Reply Brief on October 21, 2005. The application at issue in this appeal is a C-I-P application claiming priority from application 09/504,000.

On October 9, 2003, Appellant filed a notice of appeal, and on December 9, 2003 Appellant filed an Appeal Brief, appealing the final rejection of U.S. Application Serial No. 09/504,343, filed February 14, 2000 as a C-I-P application claiming priority from application 09/441,289. On February 23, 2004, an Examiner's Answer was mailed and subsequently Appellant filed a Reply Brief on April 23, 2004. The application at issue in this appeal is a C-I-P application claiming priority from application 09/504,343.

On October 24, 2003, Appellant filed a notice to appeal the final rejection of U.S. Application Serial Number 09/503,671, filed February 14, 2000 as a C-I-P application claiming priority from application 09/441,289. On November 25, 2003, after Appellant had filed the afore-mentioned notice of appeal, the Office mailed a new final rejection of all claims. In response, Appellant submitted an Amendment Pursuant to 37 C.F.R. §1.116 and a Notice of Appeal, both dated January 20, 2004. An Advisory Action was mailed on February 2, 2004.

Appellant subsequently filed an Appeal Brief on April 20, 2004. An Examiner's Answer was mailed June 4, 2004. Appellant subsequently filed a Reply Brief on August 3, 2004. Appellant received Docketing Notice assigning Appeal No. 2006-2447. The application at issue in this appeal is a C-I-P application claiming priority from application 09/503,671.

On December 12, 2003, Appellant filed a notice of appeal, and on February 12, 2004 Appellant filed an Appeal Brief, appealing the final rejection of U.S. Application Serial No. 09/702,363, filed October 31, 2000 as a C-I-P application claiming priority from application 09/441,289. Following an interview with the Examiner on May 10, 2004 and an Amendment filed May 14, 2004, application 09/702,363 has issued as U.S. Patent No. 6,952,680. The application at issue in this appeal is a C-I-P application claiming priority from application 09/702,363.

On December 12, 2003, Appellant filed a notice to appeal, and on February 12, 2004 Appellant filed an Appeal Brief, appealing the final rejection of U.S. Application Serial Number 09/653,735, filed September 1, 2000 as a C-I-P application claiming priority from the following applications: U.S. Application Serial No. 09/441,289 filed November 16, 1999; U.S. Provisional Application Serial No. 60/166,042 filed November 17, 1999; U.S. Application Serial No. 09/503,671 filed February 14, 2000; U.S. Application Serial No. 09/504,000 filed February 14, 2000; and U.S. Application Serial No. 09/504,343 filed February 14, 2000. On April 26, 2005, this Board issued a decision reversing the Examiner's rejection of all pending claims (claims 1-8 and 12-24). Pursuant to 37 C.F.R. § 41.37(c)(1)(ii), a copy of the afore-mentioned decision of this Board is attached hereto in Appendix C. Per a Notice of Allowance dated November 8, 2005, all pending claims of application 09/653,735 are allowed. The application at issue in this appeal is a C-I-P application claiming priority from application 09/653,735.

On May 4, 2004, Appellant filed a notice to appeal, and on July 1, 2004 Appellant filed an Appeal Brief, appealing the final rejection of U.S. Application Serial No. 09/714,702, filed November 16, 2000 as a C-I-P application claiming priority from application 09/441,289. Appellant filed a Reply Brief on November 2, 2004 in response to the Examiner's Answer dated September 8, 2004. The application at issue in this appeal is a C-I-P application claiming priority from application 09/714,702.

On March 16, 2005, Appellant filed a notice to appeal, and on May 5, 2005 Appellant filed an Appeal Brief, appealing the final rejection of U.S. Application Serial No. 09/990,911, filed November 14, 2001 as a C-I-P application claiming priority from application 09/441,289. Appellant received a communication from the Patent office dated August 1, 2005, noting the Appeal Brief filed May 5, 2005 is not acceptable. Appellant therefore filed an Amended Appeal Brief on August 9, 2005. A notice of Non-Compliant Appeal Brief was mailed on July 14, 2006 and Appellant filed a Supplemental Appeal Brief on August 11, 2006. The application at issue in this appeal is a C-I-P application claiming priority from application 09/990,991.

III. STATUS OF CLAIMS

Claims 1-109 were originally filed. Claims 1-22 are canceled. Claims 23-35 and 63-109 are pending but have been withdrawn from consideration. Claims 36-62 are pending, and are the subject of this appeal.

All pending claims under consideration stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which Appellants regard as the invention. Further, all pending claims stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over U.S. Patent 6,148,297 to Swor et al. ("Swor") in view of U.S. Patent 5,915,973 to Hoehn-Saric et al. ("Hoehn-Saric").

Further, although such objections are not appealable to this Board, Appellants note that claims 43, 44, 52, 53, 61, and 62 are objected to. Appellants believe that these objections are without merit, and will petition to have them withdrawn as necessary following this appeal.

IV. STATUS OF AMENDMENTS

In their Amendment After Final Action dated May 30, 2006, Appellants amended claims 43 and 44. In the Advisory Action dated July 14, 2006, the Examiner stated that these amendments would be entered.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The presently claimed invention includes methods and systems for utilizing wireless communications methods and system. The following is a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, as required by 37 C.F.R. § 41.37(c)(1)(v). Further, pursuant to 37 C.F.R. § 41.37(c)(1)(v), every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, is identified and the structure, material, or acts described in the specification as corresponding to each claimed function is set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters. However, it is to be understood that portions of the specification not cited herein may further explain and clarify the recited means. In general, the following explanation is not intended to be used to construe the claims, which are believed to speak for themselves, nor do Appellants intend the following explanation to modify or add any claim elements, or to constitute a disclaimer of any equivalents to which the claims would otherwise be entitled, nor is any discussion of certain preferred embodiments herein intended to disclaim other possible embodiments. References herein to the Specification are intended to be exemplary and not limiting.

A. Claim 36

Claim 36 recites a method for utilizing a wireless communications system having a wireless infrastructure and a wireless device associated with an asset. The method comprises receiving an operator identifier from an operator of the asset. A record of a user is created that may be stored in an analysis controller database. The information associated with the user preferably includes such data as a unique user code, user identification information (e.g., employer, location, address, and contact information) the number/class of assets for which the user is permitted access, safety record (e.g., number of accidents associated with each asset and over what period of total usage or time), and training or certification records. A user attempts to access a particular asset, e.g., through the use of an access device associated with the particular user (e.g., access card, magnetic key, or key pad code) and a corresponding approval device associated with an asset that is connected to a data acquisition device for authorization confirmation. (Specification, page 30, lines 4-13.)

The method further comprises prompting, independent of an active communication link between the wireless device and wireless infrastructure, a question related to operational status of the asset for the operator; receiving a response to the question; and storing a response to the question. In a preferred embodiment of the invention, an electronic checklist is completed by the asset operator on a regular basis, which may include information concerning asset performance that is more detailed than that available from a review of raw operational parameters. In accordance with OSHA requirements, for example, at the end of each shift, a forklift operator must complete a checklist concerning the performance of the asset during the shift. Some of the questions associated with checklist are directed to maintenance issues. Therefore, in a preferred embodiment of the invention, checklist would be completed electronically at the asset, and transmitted by way of the data acquisition device to analysis controller as discussed above. The information would be analyzed to determine if an OSHA/repair need is identified. Preferably, the analysis is automated in accordance with a comparison of the operational status with pre-determined rules. For example, if a question asks if there is a hydraulic leak for a forklift and the answer is “yes”, then maintenance would be appropriate. (Specification, page 25, lines 9-21.)

B. Claim 46

Claim 46 recites a wireless device for performing inspection of an asset utilizing a wireless communications system having a wireless infrastructure, said wireless device being associated with the asset and comprising an input unit operable to receive an operator identifier from an operator of the asset and a processing unit operable to receive the operator identifier from said input unit and operable to prompt, independent of an active communication link between the wireless device and wireless infrastructure, a question related to operational status of the asset for the operator; A record of a user is created that may be stored in an analysis controller database. The information associated with the user preferably includes such data as a unique user code, user identification information (e.g., employer, location, address, and contact information) the number/class of assets for which the user is permitted access, safety record (e.g., number of accidents associated with each asset and over what period of total usage or time), and training or certification records. A user attempts to access a particular asset, e.g., through the use of an access device associated with the particular user (e.g., access card, magnetic key, or

key pad code) and a corresponding approval device associated with an asset that is connected to a data acquisition device for authorization confirmation. (Specification, page 30, lines 4-13.)

The wireless device of claim 46 further comprises a display unit coupled to said processing unit and operable to display the question being prompted to the operator, a response to the question being prompted being received by said processing unit; and a storage unit in communication with said processing unit and operable to store the response to the question. In a preferred embodiment of the invention, an electronic checklist is completed by the asset operator on a regular basis, which may include information concerning asset performance that is more detailed than that available from a review of raw operational parameters. In accordance with OSHA requirements, for example, at the end of each shift, a forklift operator must complete a checklist concerning the performance of the asset during the shift. Some of the questions associated with checklist are directed to maintenance issues. Therefore, in a preferred embodiment of the invention, checklist would be completed electronically at the asset, and transmitted by way of the data acquisition device to analysis controller as discussed above. The information would be analyzed to determine if an OSHA/repair need is identified. Preferably, the analysis is automated in accordance with a comparison of the operational status with pre-determined rules. For example, if a question asks if there is a hydraulic leak for a forklift and the answer is "yes," then maintenance would be appropriate. (Specification, page 25, lines 9-21.)

C. Claim 55

Claim 55 recites elements including means plus function language covered by 35 U.S.C. § 112, sixth paragraph. Claim 55 recites a system for performing inspection of a mobile asset utilizing a wireless communications system having a wireless infrastructure and a wireless device associated with the asset, said system comprising means for receiving an operator identifier from an operator of the asset. The recited means include a data acquisition device that operates as follows. A record of a user that is created and that may be stored in an analysis controller database. The information associated with the user preferably includes such data as a unique user code, user identification information (e.g., employer, location, address, and contact information) the number/class of assets for which the user is permitted access, safety record (e.g., number of accidents associated with each asset and over what period of total usage or time), and

training or certification records. A user attempts to access a particular asset, e.g., through the use of an access device associated with the particular user (e.g., access card, magnetic key, or key pad code) and a corresponding approval device associated with an asset that is connected to a data acquisition device for authorization confirmation. (Specification, page 30, lines 4-13.)

Claim 55 further recites means for prompting, independent of an active communication link between the wireless device and wireless infrastructure, a question related to operational status of the asset for the operator, said means for prompting being in communication with said means for receiving. The recited means include the data acquisition device operating as follows. In a preferred embodiment of the invention, an electronic checklist is completed by the asset operator on a regular basis, which may include information concerning asset performance that is more detailed than that available from a review of raw operational parameters. In accordance with OSHA requirements, for example, at the end of each shift, a forklift operator must complete a checklist concerning the performance of the asset during the shift. Some of the questions associated with checklist are directed to maintenance issues. Therefore, in a preferred embodiment of the invention, checklist would be completed electronically at the asset, and transmitted by way of the data acquisition device to an analysis controller. The information would be analyzed to determine if an OSHA/repair need is identified. Preferably, the analysis is automated in accordance with a comparison of the operational status with pre-determined rules. For example, if a question asks if there is a hydraulic leak for a forklift and the answer is "yes", then maintenance would be appropriate. (Specification, page 25, lines 9-21.)

Claim 55 further recites means for receiving a response to the question and in communication with said means for prompting. The recited means include the analysis controller discussed in the previous paragraph, and in the above-cited portion of the Specification. Further, the analysis controller may be connected to communicate through the Internet by means of a modem or similar communications device. If desired, a communications server may be connected between the analysis controller and the modem. The communications server is provided to selectively receive and organize the information from each of a set of local controllers for delivery to the analysis controller. The analysis controller can be embodied as any conventional electronic controller that is capable of receiving the sensed operating

conditions of the forklifts and for processing that information in a desired manner described in detail below. Ideally, the sensed operating conditions of the forklifts are used to automatically generate and analyze management reports relating to the procurement and utilization of a plurality of the forklifts to maximize productivity and to reduce operating costs and administrative burdens. An input device and an output device, both of which are conventional in the art, may be connected to the analysis controller. (Specification, page 13, lines 6-18.)

Claim 55 further recites means for storing the response to the question, said means for storing being in communication with said means for prompting. The recited means include an analysis controller database, e.g., as illustrated in Appellants' Figure 5. The analysis controller database may be associated with one or more discrete analysis controllers that may be associated with one or more businesses. One or more separate databases may be combined to form a logical database. (Specification, page 17, lines 27-29.)

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. That claims 36-62 are indefinite under 35 U.S.C. § 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which Appellants regard as their invention.

2. That claims 36-62 are unpatentable under 35 U.S.C. § 103(a) over Swor in view of Hoehn-Saric.

VII. ARGUMENT

A. The Examiner's Section 112 Rejections of Claims 36-62 Should Be Reversed. (Ground of Rejection No. 1.)

1. Claims 36, 46, and 55 Are Not Indefinite under 35 U.S.C. § 112, Second Paragraph.

Claim 36 recites in part: “prompting, independent of an active communication link between the wireless device and wireless infrastructure, a question related to operational status of the asset for the operator.” In the Final Office Action (page 6), the Examiner pointed to this language as the basis for rejecting claim 36 under Section 112, second paragraph. The Examiner used this same basis to also reject claims 46 and 55, stating that those claims “recites a similar language.” (Final Office Action, page 6.)

The Examiner stated that the foregoing “limitation is directed to performing a ‘prompting’ without utilizing the wireless communication system... Therefore, it is not clear to one of ordinary skill what is Applicant’s claimed method and the scope of the method.” (See the Office Action, Pages 6 and 7). In fact, the rejection asserted by the Examiner is vague and does not provide any guidance as to why the plain language of the claim is not understood. Therefore, at least because the Examiner has not met his burden in rejecting Appellants’ claims under Section 112, this rejection should be reversed by this Board.

Further, the Examiner stated that “it is not clear to one of ordinary skill whether or not the wireless communication system having a wireless infrastructure and a wireless device is actually utilized.” (See Final Office Action, page 4). In fact, Appellants note that claim 36 clearly indicates that the limitation “independent of an active communication link between the wireless device and wireless infrastructure” applies to the step of “prompting.” Accordingly, the plain language of claim 36 particularly points out and distinctly claims Appellants’ invention. The step of “prompting” is plainly “independent of an active communication link between the wireless device and wireless infrastructure,” as claim 36 clearly recites. Further, the step of “prompting” is described in part comprising “a question related to operational status of the asset for the operator,” as claim 36 further recites. In sum, the scope of the “prompting” step in claim 36 is abundantly clear from the plain language of the claim. Because the claim limitations

clearly and definitely recite the claimed method, and incidentally make clear the scope of that method, the Examiner's rejection should be reversed.

For at least the foregoing reasons, this Board should reverse the Examiner's rejections of claims 36, 42, and 55, as well as claims 37-41, 43-54, and 56-62 depending therefrom.

2. Claim 39 Is Not Indefinite under 35 U.S.C. § 112, Second Paragraph.

Claim 39 recites in part "receiving a new question by the wireless device from the wireless infrastructure; and updating the question." In the Final Office Action, the Examiner stated that "[t]o one of ordinary skill, this is unclear as a 'new' question replaces an 'old' question one [sic], while updating a question may result in only a slight modification." (Final Office Action, page 7). Again, Appellants respectfully submit that the Examiner's lack of clarity in stating this rejection is by itself sufficient grounds for reversal. Further, Appellants note that claim 39 clearly describes "receiving a new question" and "updating the question." Claim 39 does not describe an "old" question. Thus, it appears that the Examiner is improperly attempting to read into the claim limitations that are not present in the claim language. The specific manner of "updating the question" stated by the Examiner is not recited in claim 39 and such arbitrary details may not be read into the claim. For least these reasons, the Section 112 rejection of claim 39 should be reversed.

3. Claims 43, 44, 52, 53, 61, and 62 Are Not Indefinite under 35 U.S.C. § 112, Second Paragraph.

Claim 43 recites "determining if the question is required to be prompted for the operator; and performing said prompting of the question to the operator, receiving a response to the question, and storing the response to the question, if said determining results in the affirmative." The Examiner asserted that the phrase "determining if the question is required to be prompted" is indefinite. (Final Office Action, page 7.) The Examiner's reasoning was that, "according to the language of claim 36, it has already been determined that the operator has answered in the affirmative regarding 'prompting.'" (*Id.*) The Examiner further asserted that claims 44, 52, 53, 61, and 62 all recite "similar language to claim 43," and therefore rejected those claims on the same basis as claim 43.

Once again, the Examiner's rejection lacks clarity, and should be reversed as least on that basis alone. Further, claim 43 clearly depends on claim 36, and clearly limits the conditions

under which the “prompting of the question” may occur. Therefore, claim 43 is clear on its face, and also is clearly a proper dependent claim in as much as it limits claim 36.

For at least these reasons, the Section 112 rejection of claim 43, and also claims 44, 52, 53, 61, and 62 should be reversed.

B. The Section 103 Rejections of Claims 36-62 Should Be Reversed. (Ground of Rejection No. 2.)

1. Summary of the Applicable Law

MPEP § 2143 sets forth the basic requirements for the Patent and Trademark Office to establish *prima facie* obviousness as follows:

To establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

See also In re Linter, 458 F.2d 1013, 173 USPQ 560, 562 (CCPA 1972). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990), *W.L. Gore and Associates, Inc. v. Garlock, Inc.* 220 USPQ 303 (Fed. Cir., 1966). Moreover, the fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993).

In re Oetiker further provides that “[t]here must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination.” *In re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cir. 1992). “The Examiner must show reasons that the skilled artisan, confronted with the same problem as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.” *In re Rouffet*, 47 USPQ2d 1453, at 1458 (Fed. Cir. 1998) (emphasis added).

As established by Federal Circuit precedent, to establish a *prima facie* case of obviousness, the Examiner must provide some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. *See, e.g., Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985) (“To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references”); *In re Geiger*, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987) (“When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references”); *ACS Hosp. Sys. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984) (“Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination”); *accord*. MPEP § 2143.

It is established law that one “cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.” *Ecolochem, Inc. v. Southern Cal. Edison Co.*, 227 F.3d 1361, 1371, 56 USPQ2d 1065 (Fed. Cir. 2000) (citing *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1780, 1783 (Fed. Cir. 1988)). Indeed, “[c]ombining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability – the essence of hindsight.” *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Moreover, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

2. Summary of the Prior Art

Swor is the primary cited reference against Appellant’s claims. Swor discloses a system that “includes at least two subsystems: one for providing exposure and incident information to a health care worker and another for collecting exposure and incident data at a health care facility in a confidential manner.” (Swor, Abstract.) The information subsystem includes kiosks at

which a health care worker may select to view information on a variety of healthcare topics. (Swor, 5: 14-62.) The data collection subsystem is also accessed through a kiosk, and provides an interface through which a user answers a series of questions about an accident. (Swor, 6: 6-44.) Swor's kiosks may be networked to a server, and may include a modem for communicating with a remote facility. (Swor, 4: 22-23; 4: 34-35.) In one embodiment, Swor's system includes a "substantially portable unit" that "contains means such as a modem for communicating with a central processor" or remote facility. (Swor, 4: 45-49.) Nowhere does Swor teach or suggest wireless devices, wireless networks, or wireless communications.

Hoehn-Saric discloses a "system for controlling the administration of remotely proctored, secure examinations at a remote destination, and a method for administering examinations." (Hoehn-Saric, Abstract.) The system includes a data processor at a remote test site in communication with a central station. (Hoehn-Saric, 5: 19-21.) The central station stores test question data, which is communicated to the testing station "at an appropriate point in the testing process." (Hoehn-Saric, 7: 14-16.) Once a test has been taken and "[a]fter all questions have been answered," (Hoehn-Saric, 8: 65), then "test response data is communicated to the central station." (Hoehn-Saric, 9: 3-4.)

As discussed below, Swor and Hoehn-Saric, either alone or in combination, do not teach or suggest all of the elements of Appellants' claims.

3. Appellants' Independent Claims Are Allowable over the Prior Art of Record.

a. "receiving an operator identifier from an operator of the asset"

Claim 36 recites "receiving an operator identifier from an operator of the asset." Claims 42 and 55 each include a similar limitation. Neither Swor nor Hoehn-Saric teach or suggest this limitation, nor is there any motivation in the prior art of record for one of ordinary skill in the art to have modified the references to implement this limitation.

i. Failure of the Prior Part to Disclose Appellants' Claim Limitation

As a threshold matter, neither Swor nor Hoehn-Saric include any teaching or suggestion directed to an asset, much less an operator of an asset. As noted above, Swor is directed to a healthcare information and data collection system. Hoehn-Saric is directed to an electronic test

taking system. There is no reason, and indeed the Examiner has proposed none, why either Swor's health care system or Hoehn-Saric's test taking system would have suggested an asset or an asset operator to one of ordinary skill in the art.

The Examiner contended that Hoehn-Saric's teaching of presenting a registration card or registration number prior to entering a test kiosk teaches "receiving an operator identifier from an operator of the asset." (Final Office Action, page 8.) Appellants respectfully submit that receiving a registration number from a test-taker is plainly different than "receiving an operator identifier from an operator of the asset."

At least because the cited prior art fails to teach or suggest "receiving an operator identifier from an operator of the asset," the Section 103 rejection of Appellants' claims should be reversed.

ii. Inability to Combine References

Further, the Examiner contended that "it would have been obvious to one of ordinary skill to combine the teachings of [Swor and Hoehn-Saric] to validate the test-taker in order to prevent fraud." This statement of motivation, even if correct, which it is not (see below), highlights the fact that Swor and Hoehn-Saric could not have been combined by one of ordinary skill in the art to meet the limitations of claim 36. Indeed, the Examiner has here failed to meet the burden of a *prima facie* case of obviousness at least because the Examiner has not stated that one of ordinary skill would have reasonably expected success in attempting to combine Swor and Hoehn-Saric, much less has the Examiner explained how or why one of ordinary skill would have expected to be able to combine these references. In fact, Swor's health care system is plainly incapable of combination with Hoehn-Saric's test taking system. Therefore, the Section 103 rejection of Appellants' claims should be reversed at least because one of ordinary skill in the art would not have had a reasonable expectation of success in attempting to combine Swor and Hoehn-Saric.

iii. Lack of Motivation to Combine References

Even if Swor and Hoehn-Saric could be combined, which they cannot be, the Examiner has not explained why validating a "test-taker in order to prevent fraud" would have motivated one of ordinary skill in the art to have modified Swor with the disclosure in Hoehn-Saric of

presenting a registration card or entering a registration number prior to entering a test kiosk. Preventing fraud in test taking is clearly irrelevant to Swor's health care system. There simply could have been no motivation for one of ordinary skill to have modified Swor with requirements from Hoehn-Saric directed to preventing fraud. Swor, directed to a healthcare system, would have had no need to ensure the integrity of a test taking process. Therefore, at least because one of ordinary skill in the art would not have been motivated to combine Swor and Hoehn-Saric, the Section 103 rejection of Appellants' claims should be reversed.

b. "prompting . . . a question related to operational status of the asset"

Claim 36 recites "prompting . . . a question related to operational status of the asset." Claims 42 and 55 include similar limitations. The Final Office Action asserted that Hoehn-Saric teaches "prompting a question," but was wholly silent with respect to the requirement that the question be "related to operational status of the asset." Accordingly, the Examiner's rejection of Appellants' claims should be reversed at least because the Final Office Action fails to address each and every one of Appellants' claim limitations.

Further, Hoehn-Saric teaches the most prompting a question related to a test being taken in a kiosk. (Hoehn-Saric, 8: 54-57.) Clearly, a question in a test being taken in a kiosk is very different from "a question related to operational status of the asset." Prompting a question in a test kiosk would not even have suggested to one of ordinary skill prompting "a question related to operational status of the asset."

Therefore, at least because neither Swor nor Hoehn-Saric teaches or suggests "prompting . . . a question related to operational status of the asset," the Section 103 rejection of Appellants' claims should be reversed.

4. Appellants' Dependent Claims Are Separately Patentable.

a. Claims 37, 47, and 56

Claim 37 recites

determining that an active communication link between the asset and wireless infrastructure exists; and
transmitting the stored response to the wireless infrastructure from the wireless device if an active communication link exists, otherwise, maintaining the response to the question.

Claims 47 and 56 include similar limitations. The Examiner has admitted that neither Swor nor Hoehn-Saric, even if they could be combined, teach all of the limitations of claims 37, 47, and 56. (*See* Final Office Action, page 8.) However, without citation to any prior art, the Examiner asserted that “it is well known that data cannot be communicated successfully from one device to another unless there is a connection between the two.” (Final Office Action, pages 8-9.)

Even if the Examiner's assertion made up for the deficiencies of Swor and Hoehn-Saric, which it does not, the Section 103 rejection of claims 37, 47, and 56 should be reversed because the Examiner has not cited to support for the foregoing assertion in the prior art of record. In their paper dated May 30, 2006, Appellants seasonably requested that the Examiner provide support for the apparent taking of Official Notice. However, such support has not been provided.

Further, even if “it is well known that data cannot be communicated successfully from one device to another unless there is a connection between the two,” such knowledge in the art does not compensate for the acknowledged deficiencies of Swor and Hoehn-Saric. That is, assuming that one of ordinary skill in the art would have been aware that a data connection between devices is required for data to be successfully communicated between the two, such knowledge would not have taught or suggested “determining that an active communication link . . . exists” and if so, “transmitting the stored response” but “otherwise, maintaining the response to the question.” In sum, the Examiner has failed to address all of the limitations of claims 37, 47, and 56, and those limitations are not taught or suggested by the prior art of record. In particular, nowhere do Swor or Hoehn-Saric teachers suggest “otherwise, maintaining the response to the question.”

For at least the foregoing reasons, claims 37, 47, and 56 are separately patentable, and the Section 103 rejection of those claims should be reversed.

b. Claim 38

Claim 38 recites “assigning an identifier to the response; and storing the identifier in relation to the response.” Swor and Hoehn-Saric both teach against assigning an identifier to a response to a question, because both references teach uploading an entire set of answers to a test once a test is complete and all questions have been answered. (Swor, 5: 39-41; Hoehn-Saric, 8: 65 – 9: 4.) In fact, Hoehn-Saric discloses that “a unique identifier is assigned to the testing

event” (Hoehn-Saric, 8:65 – 9: 1), thereby further teaching against Appellants’ claim limitation. In general, because neither Swor nor Hoehn-Saric teaches communicating questions or responses to questions separately, neither Swor nor Hoehn-Saric would have had any reason to assign an identifier to a response to a question or to store the identifier in relation to the response. For least this reason, claim 38 and separately patentable, and the Section 103 rejection of claim 38 should be reversed.

c. Claims 39, 48, and 57

Claim 39 recites “further comprising: receiving a new question by the wireless device from the wireless infrastructure; and updating the question.” Claims 48 and 57 include similar limitations. In rejecting these claims, the Final Office Action simply states that “the Examiner takes Official Notice of the updating of exam questions, for example by changing questions, in order to introduce new topics, emphasize or de-emphasize material, and the memorization of questions.” (Final Office Action, page 9.)

Initially, Appellants note that the Examiner’s statement is irrelevant to their claims, which do not recite the “updating of exam questions.” The Section 103 rejection of claims 39, 48, and 57 should be reversed for this reason alone.

Further, in their papers dated January 23, 2006 and May 30, 2006, appellants seasonably challenged the Examiner’s taking of Official Notice. Nonetheless, the Examiner has failed to provide support in the prior art for the Official Noticed taken as stated above.¹ Therefore, for least this reason, the Section 103 rejection of claims 39, 48, and 57 should be reversed.

d. Claims 40-42, 45, 49-51, 54, 58-60

The Final Office Action did not substantively address the limitations of any of claims 40-42, 45, 49-51, 54, 58-60. The Section 103 rejection of these claims should be reversed for this reason alone.

¹ In fact, the Examiner ignored Appellants’ challenge to the taking of Official Notice in their January 23, 2006 paper, and in the Final Office Action (page 5) improperly stated that the “updating of exam questions” was “considered admitted prior art” because Appellants “did not sufficiently challenged the Examiner’s assertion of facts.” For the record, Appellants do not intend to admit as prior art any of the facts stated by the Examiner during the prosecution of this application, nor should Appellants’ failure, whether real or apparent, to challenge any issues or facts asserted by the Examiner, be construed as an admission thereof.

Regarding 40-42, 45, 49-51, 54, 58-60, the Final Office Action (page 10) stated that Swor and Hoehn-Saric “disclose examinations.” The Examiner then asserted that “claim language that specifies the type of questions is non-functional descriptive material as the type of questions does not alter how [Appellant's] process steps are to be performed to cheat utility of the claimed invention.” (*Id.*) The Examiner further cited in MPEP section, “2100-22,” that does not appear to exist. (*Id.*) Accordingly, appellants are uncertain as to the basis for the Examiner’s assertion, but in any event disagree with the Examiner’s conclusion.

Each of the foregoing claims includes a further limitation on their respective independent claims, and therefore are both patentable and requiring analysis by the Examiner according to the cited prior art. Further, the Examiner has incorrectly characterized at least some of the foregoing claims as specifying a “type of question.” For example, claim 42 recites “receiving the list of questions via a wireless communications link prior to said storing thereof.” This is a clear structural limitation on the method of claim 36, in addition to the further limitation of claim 42 of “the list of questions being related to OSHA compliance.” In any event, Appellants do not believe that the limitations of claims 40-42, 45, 49-51, 54, 58-60 are taught or suggested in the prior art of record, and the Section 103 rejection of these claims should be reversed for this reason, or at least because the Examiner has failed to substantively address the limitations of these claims with respect to the cited prior art.

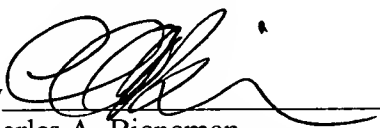
CONCLUSION

In view of the foregoing arguments, Appellants respectfully submits that the pending claims are novel over the cited references. The Examiner's rejections of all pending claims are improper because the prior art of record does not teach or suggest each and every element of the claimed invention. In view of the above analysis, a reversal of the rejections of record is respectfully requested of this Honorable Board.

It is believed that any fees associated with the filing of this paper are identified in an accompanying transmittal. However, if any additional fees are required, they may be charged to Deposit Account 18-0013, under Order No. 65678-0043, from which the undersigned is authorized to draw. To the extent necessary, a petition for extension of time under 37 C.F.R. 1.136(a) is hereby made, the fee for which should be charged against the aforementioned account.

Dated: September 28, 2006

Respectfully submitted,

By 

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APPENDIX A – CLAIMS ON APPEAL

A complete listing of the claims that are the subject of this Appeal is as follows.

36. A method for utilizing a wireless communications system having a wireless infrastructure and a wireless device associated with an asset, said method comprising:
- receiving an operator identifier from an operator of the asset;
 - prompting, independent of an active communication link between the wireless device and wireless infrastructure, a question related to operational status of the asset for the operator;
 - receiving a response to the question; and
 - storing the response to the question.
37. The method according to claim 36, further comprising:
- determining that an active communication link between the asset and wireless infrastructure exists; and
 - transmitting the stored response to the wireless infrastructure from the wireless device if an active communication link exists, otherwise, maintaining the response to the question.
38. The method according to claim 36, further comprising:
- assigning an identifier to the response; and
 - storing the identifier in relation to the response.
39. The method according to claim 36, further comprising: receiving a new question by the wireless device from the wireless infrastructure; and updating the question.
40. The method according to claim 36, wherein the question is specific to the asset.

41. The method according to claim 36, further comprising storing a list of questions related to the operation status of the asset.

42. The method according to claim 36, further comprising receiving the list of questions via a wireless communications link prior to said storing thereof, the list of questions being related to OSHA compliance.

43. The method according to claim 36, further comprising: determining if the question is required to be prompted for the operator; and performing said prompting of the question to the operator, receiving a response to the question, and storing the response to the question, if said determining results in the affirmative.

44. The method according to claim 36, further comprising: determining if the question is required to be prompted based on an operating condition of the asset; and performing said prompting of the question to the operator, receiving a response to the question, and storing the response to the question, if said determining results in the affirmative.

45. The method according to claim 36, wherein said prompting of the question includes accessing questions that relate to OSHA regulations.

46. A wireless device for performing inspection of an asset utilizing a wireless communications system having a wireless infrastructure, said wireless device being associated with the asset and comprising:

an input unit operable to receive an operator identifier from an operator of the asset;

a processing unit operable to receive the operator identifier from said input unit and operable to prompt, independent of an active communication link

between the wireless device and wireless infrastructure, a question related to operational status of the asset for the operator;

a display unit coupled to said processing unit and operable to display the question being prompted to the operator, a response to the question being prompted being received by said processing unit; and

a storage unit in communication with said processing unit and operable to store the response to the question.

47. The wireless device according to claim 46, wherein said processing unit is further operable to: determine that an active communication link between the asset and wireless infrastructure exists; and transmit the stored response to the wireless infrastructure if an active communication link exists, otherwise, maintain the response to the question.

48. The wireless device according to claim 46, wherein said processing unit is further operable to: receive a new question from the wireless infrastructure; and update the question being stored in said storage unit.

49. The wireless device according to claim 46, wherein the question is specific to the asset.

50. The wireless device according to claim 46, wherein said storage unit is further operable to store a list of questions related to the operation status of the asset.

51. The wireless device according to claim 50, wherein said processing unit is further operable to receive the list of questions via a wireless communications link prior to said storage unit storing the list of question, the list of questions being related to OSHA compliance.

52. The wireless device according to claim 46, wherein said processing unit is further operable to:

- determine if the question is required to be prompted for the operator;
- and prompt of the question to the operator if the determination results in the affirmative.

53. The wireless device according to claim 46, wherein said processing unit is further operable to:

- determine if the question is required to be prompted based on an operating condition of the asset; and
- prompt of the question to the operator if the determination results in the affirmative.

54. The wireless device according to claim 46, wherein said processing unit is further operable to access a list of questions related to OSHA regulations.

55. A system for performing inspection of a mobile asset utilizing a wireless communications system having a wireless infrastructure and a wireless device associated with the asset, said system comprising:

- means for receiving an operator identifier from an operator of the asset;
- means for prompting, independent of an active communication link between the wireless device and wireless infrastructure, a question related to operational status of the asset for the operator, said means for prompting being in communication with said means for receiving;
- means for receiving a response to the question and in communication with said means for prompting; and
- means for storing the response to the question, said means for storing being in communication with said means for prompting.

56. The system according to claim 55, further comprising:

means for determining that an active communication link between the asset and wireless infrastructure exists; and

means for transmitting the stored response to the wireless infrastructure from the wireless device if an active communication link exists, otherwise, maintaining the response to the question.

57. The system according to claim 55, further comprising:

means for receiving a new question by the wireless device from the wireless infrastructure; and

means for updating the question.

58. The system according to claim 55, wherein the question is specific to the asset.

59. The system according to claim 55, further comprising means for storing a list of questions related to the operation status of the asset.

60. The system according to claim 55, further comprising means for receiving the list of questions via a wireless communications link prior to said storing thereof, the list of questions being related to OSHA regulations.

61. The system according to claim 55, further comprising:

means for determining if the question is required to be prompted for the operator; and

means for prompting the question to the operator if the determination results in the affirmative.

62. The system according to claim 55, further comprising: means for determining if the question is required to be prompted based on an operating condition of the asset; and means for prompting the question to the operator if the determination results in the affirmative.

APPENDIX B – EVIDENCE APPENDIX

In this Appeal, Appellants do not rely on any evidence submitted pursuant to 37 CF.R.F. §§ 1.130, 1.131, or 1.132, or on any other evidence entered by the Examiner.

**APPENDIX C – THIS BOARD’S DECISION IN RELATED
CASES 09/441,289 AND 09/653,735**

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.



Paper No. 38

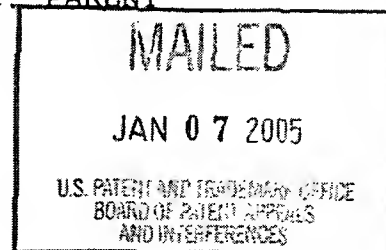
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANDREW E. SUHY and BRENT C. PARENT

Appeal No. 2004-1971
Application No. 09/441,289

ON BRIEF



Before BARRETT, BARRY, and LEVY, Administrative Patent Judges.
LEVY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 16 and 21-48, which are all of the claims pending in this application.

BACKGROUND

Appellants' invention relates to an apparatus and method for tracking physical assets. An understanding of the invention can be derived from a reading of exemplary claim 16, which is reproduced as follows:

16. A method for automatically gathering and analyzing data without human intervention relating to an asset comprising the steps of:

(a) generating a maintenance invoice from an analysis controller when service is performed on the asset, wherein the maintenance invoice includes an indication of the amount of usage of the asset, wherein said indication of the amount of usage is captured by a data acquisition device, and wherein a receiver receives the indication of the amount of usage from the data acquisition device through a transmitter;

(g) transmitting the maintenance invoice on a communication network from the analysis controller to an administrative controller;

(h) comparing on the analysis controller, the indication of the amount of usage of the asset with a predetermined standard that is representative of the warranty period; and

(I) generating a warranty report from said administrative controller without said human intervention if the amount of usage is less than the predetermined standard.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

McGuire et al. (McGuire)	4,404,639	Sep. 13, 1983
Nguyen et al. (Nguyen)	6,003,808	Dec. 21, 1999 (filed Jul. 11, 1997)
Barzilai et al. (Barzilai)	6,012,045	Jan. 4, 2000 (filed Jul. 1, 1997)
Yamamoto et al. (Yamamoto)	6,141,629	Oct. 31, 2000 (filed Jul. 13, 1998)

Sager, Business Week, "The Great Equalizer," wysiwyg://19/http://-www.businessweek.com/1998/35/z3372007/htm (May 18, 1994)

Deierlein, Beverage World, "New Lease on truck life: Automated Maintenance" ISSN: 0098-2318, v113n1566, pp. 138 (May 1994)

Claims 16 and 43-48 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Yamamoto in view of Deierlein, Sager, Nguyen and McGuire.

Claims 25-42 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Yamamoto in view of Barzilai, Nguyen and McGuire.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 34, mailed December 12, 2003) for the examiner's complete reasoning in support of the rejections, and to appellants' brief (Paper No. 33, filed September 11, 2003) for appellants' arguments thereagainst. Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered.

OPINION

In reaching our decision in this appeal, we have carefully considered the subject matter on appeal, the rejections advanced by the examiner, and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise,

reviewed and taken into consideration, in reaching our decision, appellants' arguments set forth in the brief along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer. Upon consideration of the record before us, we reverse.

We begin with the rejection of claims 16 and 43-48 under 35 U.S.C. § 103(a) as being unpatentable over Yamamoto in view of Deierlein, Sager, Nguyen and McGuire. We turn first to claim 16. In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988); Ashland Oil, Inc. v. Delta Resins &

Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole. See id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

From our review of the entire record, we note at the outset that the invoice of claim 16 does not have to be written on paper. Rather, the invoice can be displayed on a monitor. From the disclosure of Yamamoto, we find that the computer 21, which displays maintenance information such as the remaining hours until maintenance is due, is a disclosure of generating (on the monitor's display) a maintenance invoice from an analysis controller (computer 21). From the disclosure (col. 11, lines

17-23) that a determination is ordinarily made as to whether or not the user has performed maintenance, such as an overhaul or replacing consumable parts, the data is input into the computer 21, we find that the maintenance "invoice" is displayed on computer 21 when service is performed on the asset. In addition, in Yamamoto, an invoice of information regarding when maintenance is due is displayed on computer 21 when the information is sent to computer 21 by managing computer 51. In addition, as noted by appellants (brief, page 16), Yamamoto is directed to determining when maintenance should be performed, and is not directed to generating a warranty report.

From the teachings of Deierlein of accessing the truck's maintenance history, determining necessary repairs and automatically informing the technician if a repair is covered by warranty, and if so directly billing the supplier for the repair or replacement, we find that Deierlein discloses both determining needed maintenance, as well as whether the repair is covered under a product warranty, and notifying the supplier. In addition, from the disclosure of Nguyen of receiving fault codes and developing a maintenance action log and removal records, as well as a warranty report generator, we find that Nguyen also discloses determining necessary repairs and determining if a

repair is covered under a product warranty, and generating a warranty report. Because Yamamoto is directed to determining when maintenance needs to be performed, we find that an artisan, in view of the teachings of Deierlein and Nguyen, would have been motivated to provide the maintenance time determining system of Yamamoto with a system for additionally determining if a needed repair is covered by a warranty, so that the company can be repaid for the cost of the repairs. However, upon providing Yamamoto with a warranty determination system, we find that the system would be added to managing computer of network 50 of Yamamoto (see figure 12) because network 50 manages and controls the maintenance information (col. 9, lines 5-17) and updates the remaining life of the machines. We find no evidence that an artisan would have been motivated to provide the warranty determination system of Nguyen to computer 21 at monitoring station 20 of worksite 30, because computer 21 is the display location where the user inputs into the system the information as to maintenance that has been performed (col. 11, lines 17-23). Since network 50 is where the maintenance information is managed and controlled, we find that an artisan would have been motivated to add the warranty determination system at managing computer 51 of network 50. However, claim 16 recites that the analysis

controller compares the amount of usage with a predetermined standard representative of the warranty period. As the examiner relies upon elements 20 and 21 of Yamamoto as the analysis controller (answer, pages 9 and 10), we find that even if the prior art were combined as suggested by the examiner, the resultant structure would not meet all of the limitations of the claim as the comparing of usage with warranty terms would be carried out by managing computer 51 of network 50, and not by computer 21 at worksite 30. Accordingly, the rejection of claim 16, and claims 43-48, dependent therefrom, is reversed.

We turn next to the rejection of claims 21-42 under 35 U.S.C. § 103(a) as being unpatentable over Yamamoto in view of Barzilai, Nguyen and McGuire. The examiner acknowledges (answer, page 7) that Yamamoto does not teach, inter alia, automatic determination of whether or not maintenance has been performed at the analysis controller. The examiner asserts (id.) that it would have been obvious to one of ordinary skill to allow the analysis controller to perform such a function.

From our review of Yamamoto, we find that Yamamoto discloses (col. 8, line 62 through col. 9, line 4) that:

A computer 21 having functions for coordinating the control of the vehicles within the work site 30 is installed in the monitoring station 20. This computer

21 comprises an input device for inputting information pertaining to maintenance (in-house maintenance) performed by the user in the work site 30 as will be described below, and a display device for displaying, to the user in the work site 30, maintenance information such as the remaining life until maintenance due time (remaining hours) for each of the plurality of vehicles 10, 11, ..., at the work site 30.

From this disclosure of Yamamoto, we find that at computer 21, which the examiner considers to be the claimed analysis controller, information pertaining to maintenance information performed by the user is input by the user. Because the maintenance information is input by the user, we agree with the examiner that Yamamoto does not teach that the analysis controller makes an automatic determination of whether or not maintenance has been performed. Claim 21 recites that "said analysis controller being configured for automatically determining without human intervention whether maintenance of the asset has been provided."

We are not persuaded by the examiner's assertion (answer, page 7) that "[i]t would have been obvious to one of ordinary skill to allow the analysis controller to support such a function" because the analysis controller is linked to the administrative controller. The fact that the computer 21

(analysis controller) and the network 50 (administrative controller) communicate back and forth with each other (col. 9, lines 24-30) is not a teaching of charging input by a user into an automatic determination without human intervention, as required by independent claim 21.

On pages 14 and 15 of the answer, the examiner takes the position that with respect to claim 21, the examiner considers network 50 to be the analysis controller. Irrespective of whether the examiner considers computer 21 or network 50 (having managing computer 51) to be the claimed analysis controller, the fact that the maintenance information is inputted by the user into computer 21 or computer 55 (described, supra) and then transmitted to network 50, does not teach or suggest that the input of information by the user results in the maintenance information being automatically determined, without human intervention, due to the configuration of the analysis controller.

We note the disclosure of Yamamoto (col. 12, line 63 through col. 13, line 3) that when an engine is overhauled at a maintenance plant information to this effect is input by an input device to computer 55 at the maintenance plant, and then input to managing computer 51 via global network 50. From this disclosure

of Yamamoto, we find that input maintenance performed can be input to computer 21 or to computer 55 and then input to managing computer 51. Thus, we find that managing computer 51 does not make an automatic determination, without human input, of maintenance provided. Accordingly, neither computer 21 of monitoring station 20 nor managing computer of network 50 automatically determines, without human intervention, whether maintenance to the asset has been provided. The other references do not make up for this feature missing from Yamamoto. Accordingly, even if we combined the prior art as asserted by the examiner, the resultant combination would not meet all of the limitations of claim 21. Accordingly, we find that the examiner has failed to establish a prima facie case of obviousness of independent claim 21. The rejection of claim 21, and claims 22-30, dependent therefrom, under 35 U.S.C. § 103(a) is therefore reversed.

We turn next to independent claim 31. We reverse the rejection of claim 31 because claim 31 recites, identically to claim 21, that "said analysis controller being configured for automatically determining without human intervention whether maintenance of the asset has been provided." Accordingly, the

rejection of claim 31, and claims 32-37, dependent therefrom, is reversed.

We turn next to the rejection of claims 38-42. We observe at the outset that appellants do not provide any separate arguments for independent claim 38, and groups claim 38, inter alia, with independent claim 21. In contrast to independent claim 21, which recited that the analysis controller is configured for automatically determining without human intervention whether maintenance of an asset has been performed, claim 38 does not recite that the determination is automatic, or that the determination is done without human intervention. We note the disclosure of Yamamoto (col. 11, lines 17-19) that "[n]ext, a determination is ordinarily made as to whether or not the user has performed maintenance (in-house maintenance)." Yamamoto discloses that after the maintenance information is input, an addition point associated with the type of maintenance is added to the current score of the component (col. 11, lines 24-28). Although this determination is not automatic or done without human input, it is a determination made as a result of the configuration of computer 21. In addition, we find that as shown in figure 12 of Yamamoto, that assets 11, 12, and 13 do not necessarily communicate directly with monitoring station 10, but

rather can communicate through assets 10 and 13. In order to communicate with monitoring station 20 through assets 10 and 13, these assets will inherently contain a controller, to the extent that the controller has been broadly set forth in claim 38. In addition, we note that claim 38 does not recite a comparison related to a predetermined standard representative of a warranty period or the generation of a warranty report as recited in independent claim 16. We are not persuaded by appellants' assertion (brief, page 17) that:

the claims of Claim Group B are not obvious because the cited references do not teach all of the claim limitations of Claim Group B. Omissions in the cited art that are discussed below include: (i) an analysis controller located at a second location remote from said local controller; (ii) a data acquisition device to [sic, for] sensing at least one operating characteristic; and (iii) transmitting acquired data from the acquisition device through space to said receiver.

Local controllers 10 and 13 transmit over space to monitoring station 10 which transmits over space "J" to managing and control network 50, including managing computer 51. In addition, assets 11 and 12 have data acquisition devices which transmit information to monitoring station 20 via local controllers 10 and 13. Moreover, controllers 10 and 13 transmit data acquired from acquisition devices on assets 11 and 12 to monitoring station

20, which transmits the information to network 50. We are not persuaded by appellants' assertion (brief, page 20) that no cited reference discloses an administrative controller separate from said analysis controller because claim 38, unlike independent claim 16, does not recite an administrative controller separate from the analysis controller.

Nor are we persuaded by appellants' assertion that there is no motivation for combining the references. We make reference to our findings, supra, for combining the teachings of Yamamoto and Nguyen. In addition, although claim 38 does not recite the term "warranty," the claim refers to responsible parties which we construe to mean manufacturers whose product(s) are covered by warranties. Upon providing Yamamoto with the warranty determination system of Nguyen, the managing computer 51 would be able to determine if a needed repair was covered by a warranty, and if so, which manufacturer was responsible for the cost of the warranty repair/replacement of an asset or part of an asset. However, although computer 21 may be considered to provide a determination of whether maintenance has been provided (Yamamoto col. 11, lines 17-19) managing computer 51 is not disclosed as making a determination of whether maintenance has been provided. Upon combining the teachings of Yamamoto and Nguyen, the result

would be that the warranty determination system of Nguyen would be provided in the managing computer 51 of network 50. However, claim 38 requires that the analysis controller, in addition to determining whether maintenance of an asset has been provided, also automatically determines which responsible party is responsible for the maintenance performed. Since managing computer 51 would be automatically determining the responsible party, and computer 21 would be determining if maintenance has been provided, the two computers, on separate networks, cannot be considered to be the same analysis controller. The examiner relies upon Barzilai for a disclosure of collation of data to obtain warranty data, and particularly for a teaching of the company who will fulfill and correct the warranty problem. In addition, the examiner relies upon McGuire for a disclosure of automated invoicing.

With respect to Barzilai, we find the reference to be cumulative of the disclosure of Nguyen who discloses a warranty determination system, including the generation of warranty reports, and does not overcome the basic deficiencies of Yamamoto and Nguyen. In addition, as claim 38 does not recite invoicing, we find McGuire to be cumulative to the teachings of Yamamoto, Nguyen and Barzilai. From all of the above, we find that the

prior art fails to suggest all of the limitations of independent claim 38. Accordingly, the rejection of claim 38 under 35 U.S.C. § 103(a), and claims 39-42 which depend therefrom, is reversed.

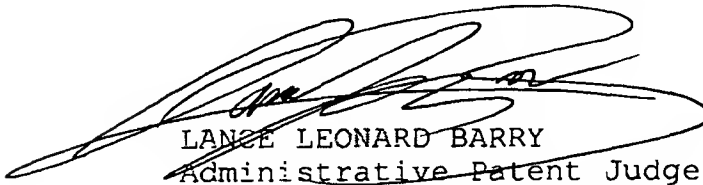
CONCLUSION

To summarize, the decision of the examiner to reject claims 16 and 25-48 under 35 U.S.C. § 103(a) is reversed.

REVERSED


LEE E. BARRETT

Administrative Patent Judge


LANCE LEONARD BARRY

Administrative Patent Judge


STUART S. LEVY

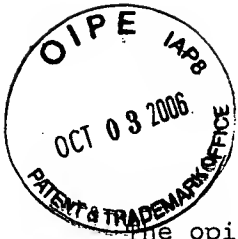
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The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 20

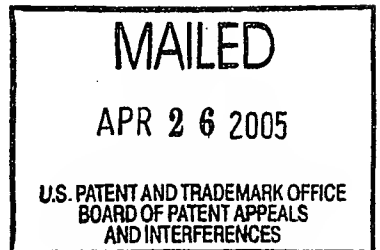
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANDREW F. SUHY, JR.

Appeal No. 2005-0013
Application No. 09/653,735

ON BRIEF



Before BARRETT, BARRY, and LEVY, Administrative Patent Judges.
LEVY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-8 and 12-24, which are all of the claims pending in this application.

BACKGROUND

Appellants' invention relates to an apparatus and method for tracking and managing physical assets. An understanding of the

invention can be derived from a reading of exemplary claim 1,
which is reproduced as follows:

1. A system for gathering and analyzing data relating to a non-fixed movable asset comprising:

a local controller located at a first location for acquiring data that is representative of at least one operating characteristic of the asset;

an analysis controller located at a second location that is responsive to said acquired data from said local controller for generating an analysis of said acquired data; and

an electronic communications network connected between said local controller and said analysis controller and permitting transmission of said acquired data from said local controller to said analysis controller; and

a sub-system that analyzes said at least one operating characteristic of the asset to determine a lease rate for the asset, the lease rate being a variable.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Koether	5,875,430	Feb. 23, 1999
Nguyen et al. (Nguyen)	6,003,808	Dec. 21, 1999 (Jul. 11, 1997)
Albertshofer	6,230,081	May 8, 2001 (Aug. 7, 1998)

Claims 1-7 and 12-24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Koether in view of Albertshofer.

Claim 8 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Koether in view of Albertshofer and Nguyen.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 16, mailed May 17, 2004) for the examiner's complete reasoning in support of the rejections, and to appellant's brief (Paper No. 15, filed February 17, 2004) and reply brief (Paper No. 17, filed July 19, 2004) for appellant's arguments thereagainst. Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered. See 37 CFR § 41.37(c)(1)(vii).

OPINION

In reaching our decision in this appeal, we have carefully considered the subject matter on appeal, the rejections advanced by the examiner, and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, appellant's arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

Upon consideration of the record before us, we reverse, essentially for the reasons set forth by appellant. We begin with the rejection of claims 1-7 and 12-24 under 35 U.S.C. § 103(a) as being unpatentable over Koether in view of Albertshofer. We turn first to independent claims 1, 13 and 18.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings

by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole. See id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

The examiner's position (answer, pages 5 and 6) is that Koether does not explicitly recite determining a lease rate. To overcome this deficiency of Koether, the examiner turns to Albertshofer for a teaching of an asset usage monitoring system that monitors asset performance over time for determining a lease rate. In addition, the examiner (id.) relies upon Webster's Ninth College Dictionary for a definition of "rate" which is defined as "'a quantity, amount, or degree of something measured per unit of something else'." The examiner asserts (id.) that it would have been obvious to calculate a rate based on any quantity, amount or degree of something within the scope of knowledge and understanding of an artisan, such as owners of

equipment who also maintain the equipment that they lease to others. The examiner adds that it would have been obvious to combine the systems of Koether and Albertshofer in order to accurately determine fees for the rental and leasing of capital equipment.

The examiner additionally asserts (answer, page 9) that appellant has not made clear how "rate" is defined beyond the lease rate being a variable, and that in Albertshofer the lease rate is a variable as it is based on usage. It is further argued (id.) that appellant's specification does not support as specific a definition of rate as set forth in the brief.

Appellant asserts (brief, page 9) that the prior art does not teach or suggest the claim limitation of an analysis of "at least one operating characteristic of the asset to determine a lease rate for the asset," because the prior art doesn't teach determining a lease rate as recited in claims 1, 13 and 18. It is further argued (brief, page 10) that Albertshofer teaches calculating a total lease amount based on usage duration of the vehicle or the distance it has gone, and that Albertshofer's rate is a constant independent of an operating characteristic. It is argued that Albertshofer does not teach determining a lease rate for an asset, much less determining a lease rate based on an

analysis of an operating characteristic of the asset. Appellant asserts that Albertshofer's disclosure is directed toward one-time usage of a golf cart, and that if a user rents the cart at an hourly rate of \$10, then renting it for two hours results in a total lease amount of \$20. Appellant adds that Albertshofer's rate is a constant multiplied by the variable operating characteristic, which is a usage duration, e.g., \$10 per hour. It is further asserted (*id.*) that in appellant's invention, the rate is a variable affected by an analysis of at least one operating characteristic. Appellant states (brief, page 11) that "Albertshofer does not teach determining a lease rate that can then be used as a variable in the calculation of the amount to be charged for a lease."

Appellant further asserts (brief, page 12) that there is no motivation to combine the teachings of Koether and Albertshofer. It is argued that "[t]he examiner provides no explanation as to why one of ordinary skill in the art would have been motivated by the cited references to analyze an operating characteristic of an asset to determine a lease rate for the asset. Moreover, the cited references provide no motivation for their combination." Furthermore, with regard to claim 18, appellant adds (*id.*) that neither reference discloses the claim limitation of "maintenance

information affecting said lease rate." It is argued (brief, page 13) that although Albertshofer discloses using service manuals to assist in automating vehicle maintenance, Albertshofer does not teach using maintenance information to determine a lease rate.

Upon careful review of Koether, we find the reference to be silent as to leasing of the disclosed kitchen appliances, and the examiner has failed to point to any suggestion in the reference that the kitchen appliances can be leased. Because Koether is completely silent as to leasing of the kitchen appliances, we find no teaching or suggestion to combine the teachings of Koether and Albertshofer as advanced by the examiner. However, we find Albertshofer to be closer to the claimed invention than the examiner recognized. Considering Albertshofer alone, we find that Albertshofer discloses an information system for displaying data on a golf cart (col. 1, lines 5-7). Albertshofer discloses that it is known to lease electric or engine-powered equipment in order to save on investment costs (col. 4, lines 9-12). Accounting for such services is generally done in a time-dependent fashion, or can be duty-dependent as a function of duration and intensity of use (col. 4, lines 12-15). It is

disclosed that if the duty-hour counter or distance-gone counter is tampered with, the result may be that the true wear and tear of the equipment exceeds the level as calculated by the leasing company on the basis of the information received (col. 4, lines 16-23). From the disclosure that accounting services are based on time dependency, or duration and intensity of use, and the disclosure suggesting that leases are calculated based on estimated wear and tear of the product, we find that Albertshofer teaches the determination of a lease rate by the leasing company, that is based upon operating characteristics.

In addition, from the disclosure of wirelessly transmitting collected data from the power equipment to the base station, we find teachings of a local controller on the power equipment, an analysis controller in the form of the base station, and an electronic communications network in the form of wireless communications between the power unit (golf cart) and the base station (col. 3, lines 40-43). Albertshofer additionally discloses (col. 5, lines 23-26) that "[v]ehicles, machines and equipment of all kinds, be they electrically powered, engine powered or pneumatically/hydraulically powered, as well as lifting platforms and, for instance, golf carts are suitable as

such equipment items." From the disclosure that the system can be used with a hydraulically-powered lifting platform, we find that Albertshofer suggests using the system with a forklift, as disclosed by appellant.

However, although Albertshofer teaches or suggests determining a lease rate, we find no suggestion of a sub-system in Albertshofer for carrying out the determination of the lease rate. We presume that the information gathered by the base station is somehow used by the leasing company, through their accounting methods, to determine the lease rate. However, no sub-system is disclosed for analyzing the collected data from the golf cart or other equipment and using this analyzed data in determining the lease rate. Accordingly, we find that Albertshofer alone is not sufficient to teach or suggest appellant's independent claims 1, 13 and 18 which recite a sub-system for using the operating characteristic in determining the lease rate. Thus, because Albertshofer does not disclose the claimed sub-system, Albertshofer does not teach or suggest independent claims 1, 1 and 18. The rejection of independent claims 1, 13 and 18 under 35 U.S.C. § 103(a), and claims 2-7, 14-17, 12 and 21-24, dependent therefrom, is reversed.

We turn next to the rejection of claim 8 under 35 U.S.C. § 103(a) as being unpatentable over Koether in view of Albertshofer and Nguyen. We cannot sustain the rejection of claim 8 because the examiner has not shown, nor do we find, that Nguyen makes up for the basic deficiencies of Koether and Albertshofer. Accordingly, the rejection of claim 8 under 35 U.S.C. § 103(a) is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-8 and 12-24 under 35 U.S.C. § 103(a) is reversed:

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136 (a)(1)(iv) (effective September 13, 2004; Fed. Reg. 49960 (August 12, 2004)).

LEE E. BARRETT

LANCE LEONARD BARRY
Administrative Patent Judge

STUART S. LEVY

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Appeal No. 2005-0013
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